

*The Eastman Photographic Materials Company, Ld., and Another v. The John Griffiths Cycle Corporation, Ld., and The Kodak Cycle Company, Ld., and*

*In the Matter of the Trade Mark No. 207,006 (Kodak).*

IN THE HIGH COURT OF JUSTICE.—CHANCERY DIVISION.

*Before MR. JUSTICE ROMER.—January 14th and February 23rd, 1898.*

THE EASTMAN PHOTOGRAPHIC MATERIALS COMPANY, LD., AND ANOTHER

*v. THE JOHN GRIFFITHS CYCLE CORPORATION, LD., AND THE*

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KODAK CYCLE COMPANY, LD.,

AND

IN THE MATTER OF THE TRADE MARK No. 207,006 (KODAK).

Trade Mark.—Motion to expunge.—Action for infringement and for passing off.—Same description of goods.—Calculated to deceive.—Mark expunged.—  
10 Interlocutory injunction granted.—Patents, &c. Act, 1883, Sections 72 and 90.

The E. Company invented, and had for some years used, the word "Kodak" in connection with their goods, and especially for cameras; and the word occurred in all their registered Trade Marks. The Company had made a speciality of cameras suitable for bicyclists, and the appliances for fixing the same to bicycles, and had largely advertised "Bicycle Kodaks." They held all the shares in a Limited Company called The Kodak Company, Ld., which, however, had not commenced business. In August 1897, the J. G. Company applied for and obtained registration of the word "Kodak" as a Trade Mark in Class 22 (in which the E. Company had no registered Trade Mark) for bicycles 15 and other vehicles included in that class; and in October 1897, The Kodak Cycle Company, Ld., was registered, with a nominal capital of 100l., and this Company and the J. G. Company commenced to advertise "Kodak Cycles." The E. Company and The Kodak Company, Ld., commenced an action against the J. G. Company and The Kodak Cycle Company, Ld., to restrain the 20 Defendant Companies (1) from carrying on business under the name Kodak 25

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Cycle Company, Ld.; (2) from passing off their goods as the goods of the Plaintiffs; (3) for infringing the Trade Marks of the E. Company. They moved for an interlocutory injunction, and also moved to expunge the registration of "Kodak" by the J. G. Company.

Held, that the word "Kodak" had become identified with the E. Company and with their goods, that the evidence showed a close connection between the bicycle and photographic trades, that registration had been obtained by an untrue statement to the Registrar, that the Defendants were trying to get the benefit of the reputation of the E. Company, and that the Trade Mark must be expunged as being calculated to deceive; also that the Plaintiffs were entitled to an injunction to restrain the Defendants from trading under the name Kodak Cycle Company, Ld., and from selling their goods as "Kodak."

On the 19th of August 1897, *The John Griffiths Cycle Corporation* applied for registration of the word "Kodak" as a Trade Mark for cycles and other vehicles included in Class 22. The registration was allowed under the circumstances hereinafter stated, and the Trade Mark received the Number 207,006.

At the date of the application, *The Eastman Photographic Materials Company, Ld.* (hereinafter called the *The Eastman Company*), was, and had for a considerable time been, the registered proprietors of Trade Marks Nos. 152, 182, 154, 848, 154, 849, and 155, 009, and was possessed of the good will of a business, in respect of which a Trade Mark No. 75,818 was registered. The word "Kodak" was comprised in all the said Trade Marks, but none of such Trade Marks were registered in Class 22.

On the 26th of April 1897, *The Kodak Company, Ld.*, had been registered with the object (*inter alia*) of carrying on the business of manufacturers of, and dealers in, photographic materials and apparatus in England and other countries. The beneficial interest in all the shares of this Company was, at the date of the proceedings hereinafter mentioned, vested in *The Eastman Company*, but *The Kodak Company, Ld.*, had not commenced business at the date of such proceedings.

On the 8th of October 1897, *The Kodak Cycle Company, Ld.*, was registered with the objects (*inter alia*) following: namely, to acquire and take over, as a going concern, the undertaking and business of *The Kodak Cycle Company*, and all the property, assets, and liabilities in connection therewith, to carry on the business of manufacturers and vendors of cycles, and also all apparatus and implements and things for use in sports and games, and other machines of every description, and of the various parts thereof.

On the 3rd of December 1897, *The Eastman Company* and the *The Kodak Company, Ld.*, commenced an action against *The John Griffiths Cycle Corporation*, and *The Kodak Cycle Company, Ld.*, for (1) an injunction to restrain the Defendant Companies, and each of them, from carrying on business under the name *Kodak Cycle Company, Ld.*, or under any name comprising the word "Kodak," or any name likely to mislead or deceive the public into the belief that the said defendant Company was the same Company as either of the Plaintiff Companies, or that the said Companies, or either of them, was the same as or was in any way connected with the business of the Plaintiffs, *The Eastman Photographic Materials Company, Ld.*; (2) an injunction to restrain the Defendant Companies, and each of them, from passing off, or doing any acts

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calculated to pass off, their goods, or the goods of either of them, as the goods of the Plaintiffs, *The Eastman Photographic Materials Company, Ltd.*, and in particular from issuing or publishing any advertisement, circular, or notice, and from using any trade name comprising the word "Kodak" in connection with 5 any goods not being the goods of the Plaintiff Companies, or either of the Plaintiff Companies; (3) an injunction to restrain the Defendant Companies, and each of them, from infringing the registered Trade Marks of the Plaintiffs, *The Eastman Photographic Materials Company, Ltd.*, numbered respectively, 75,818, 152,483, 154,848, 154,849, and 155,009, or any of them, and for consequential 10 relief.

The Plaintiff Companies on the same date gave notice of motion for an interlocutory injunction in the terms of the writ.

On the 9th of December 1897, the Plaintiff Companies gave notice of motion for an order that the Register of Trade Marks might be rectified by the removal 15 of the said Trade Mark No. 207,006, or, in the alternative, by limiting the registration of the said Trade Mark to use for vehicles other than cycles.

Both motions were partially opened on the 14th of January 1898, but were then ordered to be set down in the non-witness list, and now came on for hearing.

20 Affidavits in support of the motions were made by Messrs. *George Dickman* (the managing director of *The Eastman Company*), *J. A. Smith*, and *H. T. S. Forbes*. Mr. *Dickman's* affidavit, in addition to the facts stated above, contained (*inter alia*) statements to the effect that *The Eastman Company* carried on business in Great Britain, and in Paris and Berlin, as makers of and dealers in 25 photographic materials and other goods which could be conveniently dealt in in connection with their trade in such photographic materials; that *The Eastman Kodak Company*, of New York, carried on a similar business in the United States, and was connected in business with *The Eastman Company*; that for many years the said Companies, exclusively, had used the word "Kodak" 30 as a trade name, and in connection with their said respective businesses, *The Eastman Company* alone using the said name in Great Britain and Ireland; that *The Eastman Company* had very extensively advertised that word in connection with their goods in Great Britain and Ireland; that, by reason of the use and advertisement aforesaid, the said word "Kodak" had come to be 35 understood by the public in Great Britain and Ireland to indicate that any goods in connection with which it was used were the goods of *The Eastman Company*, and that any business in connection with which it was used was the business of *The Eastman Company*; that the word "Kodak" was the trade name of *The Eastman Company*; that *The Eastman Company* had a special 40 type of camera, which they sold as the "Kodak Camera," for use by bicyclists; that "Bicycle Kodaks" had been extensively advertised by *The Eastman Company* (show-cards and advertisements containing these words prominently being exhibited); that the nominal capital of *The Kodak Cycle Company, Ltd.*, was 100*l.*, and that its only members were the seven signatories to its Memorandum 45 of Association, who signed the same for one share each, and that the said Company had no registered address; that the Defendant Companies had recently commenced to advertise goods as "Kodak Cycles"; that the necessary result of the said advertisements, and of the use of the word "Kodak" by the Defendant Companies, as hereinbefore stated, would be to lead the public, and to lead 50 customers of *The Eastman Company*, to believe that *The Eastman Company* was commencing to deal in bicycles, and that the bicycles of the Defendant

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Companies were those of *The Eastman Company*, or that the business of *The Kodak Cycle Company, Ltd.*, was the business of, or was connected with, the business of, *The Eastman Company*, and that since the commencement of the action he had become aware of the registration by the first-named Defendant Company of the word "Kodak." Mr. *Smith*, a cycle agent and dealer in photographic materials, deposed as to seeing an advertisement of "Kodak" "Cycles," and concluded that *The Eastman Company* were making cycles; and he and Mr. *Forbes* stated that cycles and photographic materials were frequently sold in the same shops.

Affidavits in opposition to the motions were made by Messrs. *F. C. Baisley* 10 (Manager of the Patents and Trade Marks Department of the first-named Defendant Company), *J. W. Stocks* (a director of the secondly-named Defendant Company), and *H. Clark*. Mr. *Baisley*'s affidavit contained statements to the effect that he attended at the Patent Office before the Registrar in support of the application for the Trade Mark "Kodak," and that the attention of 15 the Registrar was especially drawn to the ownership of the word "Kodak" by the Plaintiff Company, in respect of cameras and photographic materials generally, and that the *ponent* stated to the Registrar, what to the best of his belief then was, and was still, the fact that the word "Kodak" had never been used in any way in connection with cycles, and that the 20 Plaintiff Company had no trade in cycles, nor to the best of his belief had they ever had any dealings in or connection with the cycle trade, and that the registration was then proceeded with, and he denied that the secondly-named Defendant Company was promoted in order to appropriate the 25 trade name of the Plaintiff Company, and stated that there was absolutely no goodwill in the word "Kodak" in connection with the cycle trade, and that the first-named Defendant Company thereby undertook never to use the word "Kodak" in connection with any cameras or photographic materials not purchased from the Plaintiff Company, and that the word "Kodak" in the Plaintiff's advertisements related solely to the camera and its accessories. 30 Mr. *Stocks*'s affidavit contained statements supporting those contained in Mr. *Baisley*'s affidavit, and offered a similar undertaking on behalf of his Company. Messrs. *Dickman* and *J. S. Whatton* made affidavits in reply.

*Moulton*, Q.C., and *D. M. Kerly* (instructed by *Kerly, Son, and Verden*) appeared for the Plaintiffs; *Ingle Joyce* (instructed by the solicitor for the 35 Board of Trade) for the Comptroller; *A. J. Walter* and *J. H. Gray* (instructed by *J. B. and F. Purchase*) appeared for the Defendants.

*Moulton*, Q.C., and *Kerly* for the Plaintiffs.--We move for an injunction, and also to rectify the register. We are not registered in Class 22, but the evidence shows a close connection between the bicycle and photographic 40 industries. The use of the word by the Defendants would lead people to believe that their bicycles were connected with our Company. We might wish to make and sell bicycles under our name "Kodak." The Court does not consider only the class for which the Trade Mark is registered; *Australian Wine Importers' Trade Mark*, 6 R.P.C. 311, and *Dunn's Trade Mark*, 7 R.P.C. 45 311. This case comes within the principle of those cases. [ROMER, J.—[Here the mark is already registered]. We did not know that. If, when a mark is challenged, it is shown that registration might have been successfully opposed, the mark may be taken off. There is no excuse for taking our word. We are very near the same trade; the question must be looked at from a business 50 point of view. *Dunn's Trade Mark* was a weaker case, as the words "Fruit Salt"

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were ordinary English words, and had been struck off the register as descriptive. It is not the same question as in an action for an injunction. If the words are calculated to deceive, the Comptroller's discretion does not arise. To prevent deception, the Courts will go far; *Reddaway v. Banham*, 13 R.P.C. 218. The 5 *Kodak Cycle Company* is a mere shadow of *The Griffiths Company*. "Kodak" means *The Eastman Company*, and has never been used except by them, whose invention it was. The evidence shows a close connection between the cycle and photo trades. We have largely advertised "Bicycle Kodaks"; they have simply inverted the order of these words. The result of the evidence is to 10 show that bicycles are goods of the same description as part of our trade. We have the evidence of *Smith, Forbes, and Whatton*, persons actually misled. *Baisley's* statement to the Registrar was untrue, and if registration was obtained by misrepresentation, however innocent, the mark must be struck off; *Baker v. Rawson*, 8 R.P.C. 89, and *The Apollinaris Company's Trade Marks*, 8 R.P.C. 15 137. The real question, under both motions, is whether the use of "Kodak" is calculated to deceive. Where fraud is intended, the Court will presume success; per *Kay, L.J., Paine and Co. v. Daniell and Sons' Breweries, Ltd.*, 10 R.P.C. at page 225. No explanation is given of the taking of our name. They use it for second grade machines. The bicycle and photograph trades overlap, thus one 20 of the tests in *The Australian Wine Importers'* case is met. The other test is also met, for the same purchasers want both goods. Then, on the motion in the action, we show that the "Kodak" cycle would be an instrument of fraud. The Court looks at the probability of the ultimate purchaser being deceived; *Lever v. Goodwin*, 4 R.P.C. 492.

25 *Ingle Joyce* for the Comptroller.—I raise no question if it is not proposed to put any note on the Register.

*Gray* for the Defendants.—In order to succeed on the motion to rectify, they must obtain such a wide construction of the words "calculated to deceive" that any trader registered in one class might object to the same mark in any 30 other class and get it removed. The goods must be of the same description. The connection suggested here is not sufficient. An appliance for fixing a camera to a cycle is not a cycle accessory; it is rather a camera accessory. The explanation as to our taking the name is sufficient. It was taken from another 35 industry. There could not be any question of taking any goodwill of that industry. The benefit of registration is to be limited to the goods in connection with which the mark is used—*Edwards v. Dennis*, 30 Ch.D. 454; *Braby and Co.'s Applications*, 21 Ch.D. 222; the dictum of Lord Westbury in the *Leather Cloth* case quoted *Kerly*, page 31; *Hart v. Colley*, 7 R.P.C. 93. In *Dunn's Trade Mark* there was evidence that the "Fruit Salt" had been used as baking powder. In 40 *The Australian Wine Importers'* case, the Court was not sure whether wine and spirits were the same description of goods; see also *Turney and Sons' Trade Mark*, 11 R.P.C. 37. In the present case, we are now on the register. The Plaintiffs must show the goods would be taken for the very goods for which the mark or name is used. "Kodak" is only used for a camera as a 45 whole, not for the appliances. I submit there would be no interference with Plaintiffs' name, and there would be no possibility of our goods being mistaken for theirs.

*ROMER, J.*—In dealing with these motions, I need not distinguish between the two Plaintiff Companies, for practically they are one and the same 50 Company, and I shall refer to *The Eastman Photographic Materials Company, Ltd.*, as the Plaintiff Company.

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Now, the Plaintiff Company carries on a very large business. Some years since it invented the word "Kodak," which it applied to certain of its cameras. Those cameras have become very well known indeed throughout the length and breadth of this land under the term "Kodak." The "Kodak Cameras" were largely advertised; they have become well known to the public, and the 5 term is identified as applied to cameras, and as denoting the goods of the Plaintiff Company; in fact, you may say that the name "Kodak" is identified with the Plaintiff Company, and is, as it were, the Trade Mark of that Company. Several Trade Marks have been registered by the Plaintiff Company in which the word "Kodak" forms a prominent part. It appears that the "Kodak 10 "Cameras" are especially available for use on cycles, and that they are much used by cyclists, and the Plaintiff Company has done a large trade in these "Kodaks" for the purpose of cycles. It has made certain special forms of "Kodaks" so as to especially adapt them for use on cycles. It has advertised for some time these special "Kodaks" as "Cycle Kodaks" or "Bicycle Kodaks," 15 and it also has a considerable trade in bicycle accessories so far as relates to the adaptation of the bicycle for photographic purposes. At one recent large cycle show the Plaintiff Company had a stall, and the evidence shows that between the two trades, the bicycle trade and the camera trade, there is an intimate connection. Many shops sell and deal in both bicycles and photographic 20 cameras and materials. To a certain extent the Plaintiff Company is identified with the name "Kodak" as connected with cycles, and so great is the connection between the two classes of business, that in all probability, I may say, the Plaintiff Company may wish hereafter to manufacture and to sell cycles specially adapted to carry their "Kodaks." That was the position of affairs 25 when the Defendants began to do what I am going to call attention to. *The John Griffiths Cycle Corporation, Ltd.*, had for some time been selling bicycles under the names of "Dunlop" and "Aerial." It suddenly, and, so far as appears, for no reason, unless it be the reason which I will hereafter suggest, adopted the word "Kodak" as applied to its cycles, or certain of the cycles which it is 30 selling. On the 19th of August last year that Company applied to have registered, and on the 4th of December 1897 it obtained registration of, the word "Kodak" for the purpose of denoting its goods as applied to the class in which cycles appear. It obtained that registration upon a statement, which was clearly inaccurate now that the facts are known, that the word "Kodak" had 35 never been used in any way in connection with cycles, and that the Plaintiff Company had never had any dealings in, or connection with, the cycle trade. The Defendant Company was not content with merely registering that Trade Mark, for, on the 6th of October of last year, it incorporated its co-Defendants under the name of *The Kodak Cycle Company, Ltd.*, clearly a mere creature of 40 its own, though, of course, a corporation; and it is obvious to me that the reason why the Defendant Company registered the word "Kodak," and why it started and incorporated its co-Defendants under the name of *The Kodak Cycle Company, Ltd.*, was really to try and get a monopoly of the word "Kodak" as connected with cycles, and, in my opinion, it wanted to use the word "Kodak" 45 and acquire a monopoly of it, as applied to cycles, in the hope and intention of, in some shape or other, identifying their Company with the Plaintiff Company whose "Kodaks" were so well known in the market—to cause the public to suppose either that the Defendant Company, under its own name or under the name of *The Kodak Cycle Company, Ltd.*, was the Plaintiff Company, or was, 50 at any rate, connected with the Plaintiff Company, or to lead the public to

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suppose that the goods which the Defendant Company was going to sell were the goods of the Plaintiff Company, and so to obtain the benefit of the large reputation, and the benefit also of the expenditure of the Plaintiff Company. With that object also the Defendants have commenced recently to sell cycles,

5 though they do not manufacture them, under the title of "Kodak Cycles."

Now, under the circumstances, the first question which arises is:—ought the name "Kodak" to remain upon the Register of Trade Marks as the Trade Mark of the Defendant Company? It came to be registered because the Plaintiff's unfortunately did not notice the advertisements of the application to register: 10 but directly the Plaintiff Company ascertained the fact of the registration and the fact of what was being done by the Defendants it immediately made these motions, both to expunge the Trade Mark and to obtain the injunction which I will hereafter mention.

On the findings of fact above mentioned, it is clear that if the application for 15 registration had been known to the Plaintiff Company and had been opposed, no registration ought to have been made, and if an application had been made to the Court by the Defendant Company when applying to register the word "Kodak," I think that application would have been refused on the same grounds which form the decision in the case of *Eno v. Dunn*, namely, that 20 the word "Kodak" as the Trade Mark of the Defendant Company was likely to deceive. It would deceive, in my opinion, the public into the supposition that the Defendant Company or the Defendants were the same Company as the Plaintiff Company, or at any rate connected with that Company, and that its goods were the goods of the Plaintiff Company. 25 I have already said that no intelligible reason has been or can be suggested why the Defendants took the term "Kodak" to be applied to their cycles, or registered that word as a Trade Mark, or used it as the title of the Company, except for the purpose of connecting themselves in some way with the Plaintiff Company and its business; and, as I have said, I think the facts show that that 30 was their real and sole object. Does it make any difference that registration has in fact been granted, and that the case is not one of mere application by the Defendant Company to register? I think not in the circumstances of this case. I do not mean to say that, in considering an application to expunge a 35 registered Trade Mark, the applicant is in the same position as he would have been had he been opposing an application of the other side to register; but in considering whether an application to expunge should not be granted, if an opposition to an application to register would have been successful, one ought to consider two things—first, what was the reason of the delay in the application to expunge; secondly, has there been any substantial injury caused to the 40 person who has registered his Trade Mark through the application not having been made until after registration? Now, in this case I can find no real delay at all, and it seems obvious that the only reason why an application was not made to oppose the registration was because the Plaintiff Company was not aware of the application. Nor has there been, in my opinion, any substantial 45 alteration in the position of the Defendants because of the registration. The Defendant Companies are not manufacturers, and the circumstances are such as, in my opinion, prevent them saying that they have in good faith so acted on the registration as to put them in a worse position than they would have been if the application had been opposed before registration. So far, therefore, 50 as concerns the Trade Mark, for the reasons I have given, it must, in my opinion, be expunged.

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Then I have to deal with the application for an injunction against the Defendants in respect of what they are doing. They have just started business practically, and it appears to me that to allow them to use the word "Kodak" as part of the title of *The Kodak Cycle Company, Ltd.*, would be to give them the benefit of what, in my opinion, substantially amounts to an improper dealing on their part. It would be to allow this Company certainly to cause confusion between it and the Plaintiff Company. I think it would injure the Plaintiff Company, and would cause the Defendant Company to be identified with the Plaintiff Company, or to be recognised by the public as being connected with it, and I think, accordingly, the Defendants, *The Kodak Cycle Company, Ltd.*, ought 10 to be restrained from carrying on business under that name. Moreover, it appears to me that they ought not to be permitted to sell their cycles under the name of the "Kodak Cycles" for similar reasons. I think it would lead to confusion; I think it would lead to deception, and I think it would be injurious to the Plaintiff Company.

I therefore grant an injunction to restrain the Defendant Companies, or either of them, from carrying on business under the name "*Kodak Cycle Company, Ltd.*" or under any name comprising the word "Kodak" likely to mislead or deceive the public into the belief that the Defendant Company is the same Company as or is connected with either of the Plaintiff Companies, or that the business 20 of the said Companies, or either of them, is the same as, or is in any way connected with, the business of the Plaintiffs, *The Eastman Photographic Materials Company, Ltd.* I also grant an injunction to restrain the Defendant Companies, and each of them, from selling, or offering to sell, any of their cycles or goods as "Kodak." I think that will sufficiently protect the 25 Plaintiffs. Of course the Respondents, the Defendants, must pay the costs, including the costs of the Comptroller.

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